

REMARKS

Claims 27-29, 31, 34-38, and 44 will be pending upon entry of the present amendment. Claims 27, 31, and 34 are amended, claim 32 is cancelled, and claim 44 is newly submitted herewith. No new matter is added by the present amendment.

The amendments to claims 31 and 34 are made to correct errors in dependency introduced when claim 30 was cancelled, and the subject matter deleted from claim 27 in the present amendment is presented in the new claim 44.

Applicant thanks Examiner Larson for his consideration in conducting a telephone interview with the undersigned representative on August 26, 2008, during which the language of claim 27 was discussed. Applicant had noted the Examiner's comments in the recent Office Action, in which he indicated that claim 27 might be placed in condition for allowance by the incorporation of the limitations of claim 7 as originally filed. Accordingly, language for an amendment to claim 27 was proposed, substantially as presented herewith, and Applicant understands the Examiner to have agreed that as presented, claim 27 distinguishes the invention over the art of record. In particular, the Examiner indicated that the art of record fails to teach or suggest the strap-and-buckle arrangement recited, in combination with the other limitations of claim 27. Applicant also understands that the Examiner will update the prior art search before issuing a Notice of Allowance.

Applicant also thanks Examiner Larson for indicating that, if additional relevant prior art is located in updating the search, he will contact the undersigned to discuss the prior art and claim language prior to issuing a rejection.

During the above referenced telephone interview, and in discussing the allowability of the claims over the prior art, the undersigned representative made reference to the recent *KSR* decision (*KSR Int'l Co. v. Teleflex Inc., et al.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)) that clarifies the standard for obviousness under 35 U.S.C. § 103, noting that *KSR* provides additional helpful guidance in the present case. For the Examiner's convenience, those observations are expanded upon hereafter.

Applicant notes that *KSR* does not substantively change the standards by which a claim should be considered, but merely cautions against a too-rigid application of the teaching-

suggestion-motivation test in looking for a justification to combine references, recognizing the necessity of the use of common sense in evaluating claims (*id.*, at 1742). However, *KSR* offers another valuable directive that is relevant to the present question: “[in reviewing a claim under § 103,] a court [or an Examiner] must ask whether the improvement is more than the predictable use of prior art elements *according to their established functions*. (*Id.*, at 1740, emphasis added.) Applicant is of the opinion that much of the art of record cannot be combined to teach the limitations of the claims without departing from its established function to a degree that would not be predictable on the basis of the available teachings.

For example, the Vidal reference teaches a “chrysalis” 68 attached to the base end 12 of a tool handle 14, and that includes a strap 74 “adapted to conform to the back side of the user's hand” (*Vidal*, col. 3, lns. 64-65) for use especially in combination with a thumb spur 56 to improve gripping ability, control, and comfort “in the use of heavy pounding and chopping tools, such as hammers and hatchets.” (*Id.*, col. 4, lns. 5-8; see also col. 3, ln. 38 - col. 4, ln. 4.) The combination is shown in Figures 19-21, where it can be seen that the strap 74 extends substantially longitudinally with respect to the tool handle 14, as is appropriate where it is to be attached across the back side of a user's hand. However, in order to place the strap 74 “in a position to be attachable to a user's wrist,” as recited in claim 27, the position and orientation of the strap would need to be modified significantly, for which there is no teaching.

More importantly, with respect to the *KSR* instruction, a strap modified to conform to the limitations of claim 27 would no longer function to increase control or comfort in the use of heavy pounding and chopping tools, as described by Vidal. It is well known in that field of art that such tools require not only a secure grip to prevent unintended and potentially dangerous release of the tool during a swing, but also accurate control of the orientation and position of the working end of the tool, to hit a nail squarely and directly, for example. The embodiment taught by Vidal functions to enhance such control. On the other hand, a strap in a position to be attachable to a user's wrist would of necessity be only loosely attachable, because the user's wrist is positioned well beyond the base end of the handle, and because operation of such tools requires a flexible wrist. Such a strap would have no effect on the user's operation of the tool, and so would not function to increase control or comfort, or even prevent accidental

release of the tool. It would only prevent the flying away of the tool in the event of such a release. Thus, the use of Vidal's chrysalis and strap in the manner recited in claim 27 is not a predictable use according to its established function.

Finally, it is important to note the relative scope of the art considered in the *KSR* decision. The patent and claim in question (Engelgau, U.S. 6,237,565, claim 4), relates to a control pedal (i.e., an accelerator pedal) for a vehicle, that is adjustable with respect to the distance from the pedal to the drivers seat, that includes an electronic position sensor to detect a position of the pedal, i.e., the amount of pressure applied by the driver, and that is mounted on the support structure of the pedal rather than on the pedal itself (*KSR*, at 1737). The references cited that were ultimately found to render the claim obvious included Asano (U.S. 5,010,782), which taught an adjustable pedal with a mechanical throttle linkage, and Smith (5,063,811), which taught a conventional (i.e., non-adjustable) pedal, with an electronic position sensor mounted on the support structure, and also taught the benefits of such an arrangement over mechanical linkages and sensors mounted on the pedal (*KSR*, at 1735, 36, and *Smith*, col. 1, lns. 17-64). The Supreme Court agreed with the U.S. District Court in finding that Engelgau's claim 4 was obvious in view of Asano and Smith: "we see little difference between the teachings of Asano and Smith and the adjustable electronic pedal disclosed in claim 4 of the Engelgau patent." (*KSR*, at 1743.)

Applicant notes that it was not necessary for the court to look any further than the field of accelerator pedals to find relevant art. In asking whether the invention of claim 4 would have been obvious, the court, in essence, was asking whether "[a] person having ordinary skill in the art could have combined [the adjustable accelerator pedal taught by] Asano with [an accelerator] pedal position sensor [as taught by Smith] in a fashion encompassed by claim 4, and would have seen the benefits of doing so." (*Id.*, at 1743.) It was not necessary to rely on references directed to pedals other than accelerator pedals, or directed to sensors used in other applications other than to sense accelerator position. Thus, the connection between Asano and Smith was short and direct. While the court does not attempt to define the limits beyond which references from different fields of art cannot be reasonably combined, it is instructive to note just how close the references in question were, relative to each other as well as to the claimed subject

mater, in terms of the fields of art. Applicant suggests that, as the distance between the respective fields of the various prior art references increases, the likelihood of obviousness decreases, and that it is reasonable for an Examiner to take such into consideration when determining whether it is appropriate to combine such references, especially where there is some modification of the teachings necessary to make the combination.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
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